

REMARKS

Claims 1-8, 12-21, and 23-27 are pending in the application.

Claims 9-11 and 22 are cancelled.

Claims 1, 5, 14-18, 20-21, and 24 are amended.

Claims 25-27 are newly submitted with this response.

Claim Rejections - 35 U.S.C. § 103:

Claims 1-4, 12, 14, 16, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193). Applicant respectfully traverses the rejection of claims 1-4, 12, 14, 16, and 24 as being unpatentable over Mueller in view of Ellison.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" [MPEP § 2142; 8th Edition, Rev. 2, May 2004, Pg. 2100-128].

Claim 1 is amended to define, *inter alia*, a first thermoplastic material on a top side of the decorative web layer and a second thermoplastic material on a bottom side of the decorative web layer, and wherein at least one of the first and the second thermoplastic material is substantially transparent. Thus, amended claim 1 more clearly defines the invention and distinguishes it from the cited prior art.

Contrary to the present invention, Mueller discloses a process for preparing a prepreg in which the top and bottom layer are the same by passing a fibrous web through a trough and thus impregnating the web, including its top and bottom side, with the same resin material present in the trough. The instant invention as defined in amended claim 1 clearly states that a first thermoplastic material is provided on a top side of the decorative web and a second thermoplastic material is provided on a bottom side of the decorative web. At least one of the first and the second thermoplastic material are substantially transparent. This limitation was disclosed in the specification as originally filed and inherently implies that the first and second thermoplastic material, or in other words, the top and bottom side, can be of a different material, i.e. different in composition. The process disclosed by Mueller would not allow a modification to provide a different material on the top or bottom side of the web layer. Further, Mueller does not provide any suggestion or motivation to modify its process to provide a prepreg having different materials on a top or bottom side of their fibrous web material.

Furthermore, as was discussed in the previous response, Mueller merely discloses a functional web. There is no mention in Mueller of a decorative effect created by the fibrous web. Claim 1 of the instant invention, *inter alia*, defines the step of providing a decorative web layer.

Ellison discloses a paint film having a clear coat layer, a colored layer including an adhesive and at least one color pigment, and a support layer of an extruded film adhered to the color layer. The mere disclosure of a clear coat layer provided on top of an adhesive including a color pigment, in accordance with Ellison, does not provide sufficient motivation to combine the references of Mueller and Ellison. Furthermore, it is noted that Ellison discloses a paint film which does not have sufficient rigidity to form an exterior body panel for attachment to an exterior surface of a vehicle frame as defined in claim 1 of the instant invention. The present invention provides a decorative exterior body panel that does not require further processing steps to provide a finished look to a vehicle body. Thus, the method of producing an exterior body panel as defined in claim

1 produces an exterior body panel for use on automotive vehicles that can simply be fastened to a vehicle frame without further processing.

Thus, Applicant submits that there is neither a suggestion or motivation to combine Mueller and Ellison, nor is there any reasonable expectation that the combination of the two inventions would succeed. Furthermore, neither Mueller nor Ellison, or the combination of Mueller and Ellison, teaches or suggests all the claim limitations of amended claim 1.

For at least these reasons, claim 1 is submitted as allowable over the applied art. Claims 2-4, 12, 14, 16, and 24, which ultimately depend from claim 1, are likewise submitted to be allowable over the applied art. Withdrawal of their rejection is respectfully requested.

Claims 5-8, 13, 15, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193). The rejection is respectfully traversed.

Claim 5 is amended to define, *inter alia*, a first mixture of epoxy and plastic for forming a first plastic layer on one side of a decorative web material and a second mixture of epoxy and plastic for forming a second plastic layer on an opposite side of the decorative web material. Further, claim 1 defines, *inter alia*, that the first plastic layer is substantially transparent and that the second plastic layer, when the laminate is cooled, is sufficiently rigid to form an exterior body panel for attachment to the exterior surface of a vehicle frame.

Claim 5 is amended in a similar fashion as claim 1 and the discussion and arguments provided heretofore with respect to claim 1 also apply to claim 5.

Thus, Applicant respectfully submits that claim 5 is allowable for at least the reasons discussed above and that the rejection be withdrawn.

Claims 6-8, 13, 15, and 17 which ultimately depend from claim 5 are likewise submitted to be allowable for at least the reasons discussed above. Withdrawal of their rejection is respectfully requested.

Claims 18-21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193). The rejection is respectfully traversed.

Claim 18 is amended to define, *inter alia*, the step of forming a laminate by providing a first mixture of an epoxy and a thermoplastic material on a top side of the decorative web layer and by providing a second mixture of an epoxy and a thermoplastic material on a bottom side of the decorative web layer. Furthermore, claim 18 defines, *inter alia*, that the laminate is attached directly to the exterior of the frame of an automotive vehicle.

Claim 18 is amended in a similar fashion as claim 1 and claim 5 and the discussion and arguments provided heretofore with respect to claim 1 and claim 5 also apply to claim 18.

Therefore, Applicant respectfully submits that claim 18 is allowable for at least the reasons discussed heretofore.

Claims 19-21, and 23 which ultimately depend from claim 18 are likewise submitted to be allowable for at least the reasons discussed above. Withdrawal of their rejection is respectfully requested.

The dependent claims are amended to be in agreement with the amendments of independent claims 1, 5, and 18.

New claims 25-27 have been added to ensure all aspects of the invention are protected.

As such, it is respectfully submitted that all of the claims remaining in the application are in condition for allowance. Early and favorable reconsideration would be appreciated.

Should the Examiner believe anything further needs to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

As this response has been timely filed within the set period of responses, no petition for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided, or credit any overpayment to our Deposit Account.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

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Date March 28, 2005

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